

Application Number: 09/771,132

Docket Number: 10004003-1

**REMARKS**

Upon entry of this Response, claims 1-20 remain pending in the present application. Applicant requests reconsideration of the pending claims in view of the following remarks.

In item 5 of the Final Office Action, the rejection of claims 1-3, 7-8, 12, 15-16 and 20 has been upheld under 35 U.S.C. §102(e) as being anticipated by U.S. Patent 6,253,216 B1 issued to Sutcliffe et al. (hereafter "Sutcliffe"). Anticipation under §102 "requires the disclosure in a single prior art reference of each element of the claim under construction. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983). For the reasons that follow, Applicant reasserts that Sutcliffe fails to show or suggest each of the elements of claims 1-3, 7-8, 12, 15-16, and 20. Accordingly, once again Applicant requests that the rejection of these claims be withdrawn.

To begin, claim 1 provides as follows:

1. A method for filling out a form, comprising the steps of:  
maintaining a database in a server that includes a form profile having a number of data fields, the form profile being associated with a user;  
maintaining a form template in the server, the form template including a list that comprises a subset of data fields in the form profile;  
defining a form that includes a data entry from each of the data fields in the form profile that are included in the list in the template;  
and  
transmitting the form to a client in response to a request from the client.

With respect to claim 1, the Office Action states:

"Regarding independent claim 1, Sutcliffe discloses a form that has been filled out in Figure 4A at reference sign 188. Sutcliffe also recites: *"The personals-on-line network includes at least one server computer which can be accessed by the remote users. The local computer network also has at least one computer software program and at least one database located therein"* (column 2, lines 35-39) and *"In accordance with the present invention, a system for generating a page for display on a computer system accessible to a plurality of remote users through a computer network includes means for displaying at a user site at least one template, means for inputting user-data to be included in a predetermined area of the template, means for storing the user-data in a predetermined field of a database and means for retrieving the user-data from the database and for displaying the*

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*template and the user-data on a display of the computer system"*  
(column 2, lines 21-31)." (Office Action, pages 4-5).

In response to this rejection, Applicant set forth arguments in the previous Response that are reiterated herein. In reply to these arguments, the Final Office Action further states:

"Regarding claim 1, the Applicant states: "claim 1 specifies that a form is defined that includes a data entry from each of the data fields in the form profile that are also included in the list and the template" and "Sutcliffe fails to show or suggest each of these elements" (amendment of 9/20/2004, page 6, second and third paragraph).

Applicant is directed to the rejection of claim 1, as restated above. In further support of the rejection, Sutcliffe discloses in FIG. 4A, at reference sign 188, a form that has been defined. Sutcliffe's form has been defined from the data issue in shown in FIG. 3 at the database table shown at reference signs 126, 134, and 152. Sutcliffe discloses a data entry for each of the data fields in the template list in FIG. 3 at the table designated by reference sign 134; where the template is designated at reference sign 136, and a list of data fields are shown at reference sign 140 (shown as "field name") and the data is shown at reference sign 144 (shown as "field attribute")." (Office Action, page 8).

In addition, in item 22 of the Office Action the Examiner states:

"Also regarding claim 1, the Applicant recites: Nowhere does Sutcliffe show or suggest "templates" that include a list that comprises a subset of the data fields in a form profile as claimed" (Amendment of 9/20/2004, page 6, fourth paragraph). Applicant is directed to the rejection of claim 1, as restated above. In further support of the rejection, Sutcliffe discloses in FIG. 3 at the database table designated by reference sign 134, a plurality of templates at reference sign 136 (shown as "template 1" and "template 2"). Sutcliffe discloses a list that comprises a subset of data fields for each template shown in FIG. 3 at reference sign 140 (shown as "field name")." (Office Action, pages 8-9).

Applicant respectfully disagrees. Specifically, claim 1 states: "maintaining a form template in the server, the form template including a list that comprises a subset of data fields in the form profile. Applicant maintains that Sutcliffe fails to show or suggest at least this limitation. Specifically, the Examiner points to the tables on FIG. 3 of Sutcliffe and to the web page of FIG. 4A as showing or suggesting the form template that includes a list that comprises a subset of data fields in the form profile as set forth in claim 1.

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However, upon close scrutiny, Applicant notes that the above statements in the Office Action represent a misinterpretation of the teachings of Sutcliffe.

Specifically, at col. 7, lines 24-30, Sutcliffe states:

"A personal page may be generated and stored by prompting a remote user 70 who desires to generate a page to select a template for the personal page, and prompting the page creating remote user 70 to enter or select text, graphics or other information capable of being stored on the local computer network 82. Attributes which define the personal page may then be stored in the database 96."

As set forth above, the information that is entered for a particular web page is stored in the database. The database has several tables within which to store such information.

First is the user information table 126. The user information table 126 identifies each user uniquely and associates a template with each user. The templates are merely empty web pages. The templates as set forth by Sutcliffe are not "lists" of data fields that are a subset of the data fields in a form profile. Specifically, Sutcliffe teaches a template fields information table 134 in which a number of fields associated with various templates are defined. Each row of the template fields information table 134 defines a particular field for a given template. In order to generate a web page from a given template for a particular user, the user ID is associated with a template ID in the user information table 126. By determining which template ID is to be employed, the system can then proceed to the template fields information database 134 to access all of the fields for a given template based upon the template ID. These fields thus define the layout of the web page 188 as described with reference to FIG. 4A. Since the fields of the template are all employed to create the corresponding web page, where does the template include a list of data fields that are a subset of data fields set forth in a form profile? Where is the form profile?

Once the template fields are identified, the User ID is employed to look up values in the personal page values table 152 to be placed in the various fields from the templates fields information database 134 in order to generate the resulting web page. Thus, the templates of the template fields information database 134 are simply empty web pages that are defined by data fields that need to be populated with personal information from the personal page values table 152. A single template encompasses all of the rows in the template fields information table 134 for

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a given template ID. To the extent that each template is defined by the fields listed in the template fields information table 134, the templates do not include a list that comprises a subset of the data fields in a form profile.

Specifically, the Office Action has not identified a "form profile" that includes the data fields of which the template defines the subset. To the extent that the web page of FIG. 4A (reference 188) is taken as a form profile is based upon an erroneous assumption. The web page shown as an example in FIG. 4A is simply a web page that is generated by combining the template information in the template fields information table 134 with the various values in the personal page values table 152 for a particular user. Thus, the values displayed in the web page of FIG. 4A are not a list of values of which the template defines a subset. Rather, the template employs all of the respective fields from the template fields information table 134 and all of the corresponding values from the personal page values table 152 to generate a corresponding web page. No subset of any list of values is identified by the template that is employed.

In addition, in item 23 of the Office Action, the Examiner states:

"Also regarding claim 1, the Applicant recites: 'nowhere does Sutcliffe suggest creating a form that includes data taken from a form profile that corresponds to the data fields listed in the given template' (Amendment of 9/20/2004, page 6, fifth paragraph). In response to Applicant's argument that the reference fails to show certain features of Applicant's invention, it is noted that the features upon which Applicant relies are (i.e., 'creating a form') are not recited in the rejected claims."

Applicant respectfully disagrees. Even though the Examiner notes that the terms "creating a form" are not in the claims, claim 1 does recite "defining a form that includes a data entry from each of the data fields in the form profile that are included in the list in the template." Applicant asserts that the use of the term "creating" rather than "defining" was an inadvertent usage of the term, however, the idea has been relayed. Thus, stating it somehow Applicant has recited limitations that are not in the claims is to show a lack of appreciation for the full content of the claim itself.

Accordingly, Applicant asserts that Sutcliffe fails to show or suggest each of the elements of claim 1. In addition, to the extent that claims 7 and 15 include subject matter similar in scope with that of claim 1, Applicant requests that the rejection of claims 7 and 15 be withdrawn. Also, Applicant

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respectfully requests that the rejection of claims 2, 3, 8, 12, 16, and 20 be withdrawn as depending from either claims 1, 7, or 15.

In addition, in item 15 of the Office Action, claims 4, 9-11, and 17-19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sutcliffe in view of U.S. Patent Publication 2002/0091937 filed by Ortiz (hereafter "Ortiz"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). Applicant notes that claims 4, 9-11, and 17-19 depend from claims 1, 7, and 15. Accordingly, Applicant asserts that the rejection of claims 4, 9-11, and 17-19 is improper for the same reasons as was described above with respect to claims 1, 7, and 15. Therefore, Applicant respectfully requests that the rejection of claims 4, 9-11, and 17-19 be withdrawn.

In addition, in item 19 of the Office Action, claims 5-6 and 13-14 have been rejected under 35 U.S.C. §103(a) being unpatentable over Sutcliffe in view of U.S. Patent 5,563,998 issued to Yaksich (hereafter "Yaksich"). A prima facie case of obviousness is established only when the prior art teaches or suggests all of the elements of the claims. MPEP §2143.03, In re Rijckaert, 9 F.3d 1531, 28 U.S.P.Q2d 1955, 1956 (Fed. Cir. 1993). Applicant notes that claims 5-6 and 13-14 ultimately depend from claims 1 and 7, respectively. Accordingly, Applicant asserts that the rejection of claims 5-6 and 13-14 is improper for the same reasons as was described above with respect to claims 1 and 7. Also, Applicant reiterates the arguments presented with respect to claims 5-6 and 13-14 in the prior Response to the Office Action of June 4, 2004. Therefore, once again, Applicant requests that the rejection of claims 5-6 and 13-14 be withdrawn.

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**CONCLUSION**

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

  
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